REMARKS/ARGUMENTS

Claims 1-3 have been cancelled without prejudice or disclaimer, and new claims 6-17 have been added. Claims 4-17 are currently pending in this application.

New claims 6-17 have been added to further define the invention of the present application. Support for new claims 6-17 is provided, for example, at page 4, line 25 to page 6, line 7; and by Examples 1, 4 and 6.

Claims 1-3 have been cancelled to avoid double-patenting issues with co-pending commonly-owned U.S. application No. 09/958,261. A Terminal Disclaimer was filed in that case against the present application. Claims 4-17 are believed to not raise any double-patenting issues with claims in that application because the present claims recite different features or additional steps not recited in claims pending in that application. Nonetheless, the Examiner is invited to review that pending application and its prosecution history.

Rejections Under 35 U.S.C. 103(a)

Examiner has rejected claims 1 and 3 under 35 U.S.C. §103 as being unpatentable over Freel et al. (U.S. Patent No. 5,792,340) in view of Ikura et al. (U.S. Patent No. 5,120,428). Claims 1-3 have been cancelled without prejudice or disclaimer. In view of the cancellation of claims 1 and 3, Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 103(a).

Examiner has rejected claims 2-5 under 35 U.S.C. §103 as being unpatentable over Freel et al. (U.S. Patent No. 5,792,340) in view of Ignasiak et al. (U.S. Patent No. 5,338,322). Claims 2-3 have been cancelled. Applicant respectfully traverses Examiner's rejection against claims 4-5 based on the comments set forth below.

Under 35 U.S.C. §103, in order to set forth a case of *prima facie* obviousness the differences between the teachings in the cited reference must be evaluated in terms

of the whole invention, and the prior art must provide a teaching or suggestion to the person of ordinary skill in the art to have made the changes that would produce the claimed product. *See, e.g., Lindemann Maschinen-fabrik Gmbh v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 U.S.P.Q.2d 481, 488 (Fed. Cir. 1984).

The mere fact that prior art may be modified to produce the claimed product does not make the modification obvious unless the prior art suggests the *desirability* of the modification. *In re Fritch,* 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *see, also, In re Papesh,* 315 F.2d 381, 137 U.S.P.Q.43 (CCPA 1963). Freel et al. describes the rapid thermal processing of a carbonaceous material to produce a liquid product, but does not teach or suggest the *desirability* of isolating a VGO product from the liquid product produced by the disclosed process. As a consequence, there would have been no motivation for one of skill in the art to have modified the process of Freel et al. to isolate a VGO product.

Furthermore, Examiner's assertion that modification of the disclosed process of Freel et al. to meet the claimed invention would have been obvious to one of skill of the art at the time the claimed invention was made is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). As there is no teaching or suggestion in Freel et al. to have used the Athabaska bitumen disclosed in Ignasiak et al. as a feedstock for its rapid thermal processing process, there would have been no objective reason for one of skill in the art to have combined the teachings of Freel et al. and Ignasiak et al.

Claims 4 and 5 are, therefore, novel and not obvious in view of the disclosure of Freel et al. and Ignasiak et al.

In view of the cancellation of claims 2-3 and the above comments, Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 103(a).

CONCLUSION

In view of the above amendments and remarks, a Notice of Allowance is requested.

Respectfully submitted,

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